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OFFICE OF PETITIONS

In re Reissue Application of:	:	
Lee et al.	:	
Reissue Application No. 09/933,918	:	
Filed: August 21, 2001	:	
Original Patent No. 5,637,345	:	DECISION DENYING PETITION
Issue Date: June 10, 1997	:	
For: METHOD OF MANUFACTURING	:	
POWDERED DEER BLOOD	:	

This is a decision on the petition under 37 CFR 1.182 filed July 3, 2002, to withdraw the terminal disclaimer recorded against the above-identified patent, and accept the corrected terminal disclaimer proffered with the instant petition in this reissue application

The petition to withdraw the terminal disclaimer recorded against the above-identified patent is DENIED.

BACKGROUND

Application No. 08/584,748('748) was filed January 11, 1996, styled as a continuation in part of application No. 08/284,159 filed August 2, 1994, which issued as US Patent No. 5,05,980('980) on April 9, 1996.

The Office action of June 3, 1996 in the '748 application contained, *inter alia*, a rejection of the claims on the judicially created doctrine of obviousness type double patenting over the claims of the '980 patent.

In reply, on September 6, 1996, a terminal disclaimer was filed to overcome the above-noted rejection. While the disclaimer was drawn to U.S. Patent No. 5,460,677('677), rather than the '980 patent relied upon in the Office action, in due course the '748 application issued as US Patent No. 5,637,345('345) on June 10, 1997, with the terminal disclaimer in full force and effect.

The instant application for reissue of the '345 patent was filed on August 21, 2001, along with a terminal disclaimer drawn to the '980 patent.

The instant petition was filed July 2, 2002 in this application for reissue and seeks that the terminal disclaimer recorded in the patent withdrawn.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law,
which...

(A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 251 states:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 253 states in pertinent part:

A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall

thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

37 CFR 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.321 states in pertinent part:

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
- (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
- (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.325 states:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or reexamination, will not be corrected after the date of the patent.

OPINION

Petitioner seeks by way of petition in this reissue application, to withdraw the terminal disclaimer recorded in the '345 patent over the '677 patent. Petitioner notes, inter alia, that, notwithstanding the averments in the terminal disclaimer filed under 37 CFR 1.321(c) recorded against the '345 patent, there is no common ownership between the '677 patent and the instant reissue and original patent.¹

Unfortunately, once a patent issues, the USPTO will not remove the effect of a recorded terminal disclaimer in an issued patent. See Manual of Patent Examining Procedure (MPEP) § 1490(B); Bayer AG v. Carlsbad Technology Inc., 64 USPQ2d 1045, 1048-49 (Fed. Cir. 2002). While petitioner may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioner is, nevertheless, confronted with what has been characterized as "an unhappy circumstance," rather than a circumstance necessitating relief. See In re Jentoft, 392 F.2d 633, 639 n. 6, 157 USPQ 363, 368 n. 6

¹ It is noted, without deciding the issue, that the terminal disclaimer of record in the '345 patent, due to the lack of common ownership and since it is not directed to the patent relied upon in the rejection, might nevertheless be considered applicable under the provisions of 37 CFR 1.321(b). In any event, as explained in the body of the decision, the USPTO will not mitigate whatever effect that disclaimer might have on the issued '345 patent.

(CCPA 1968); MPEP 1490(A).

What is here controlling is that petitioner seeks to correct an issued patent. The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 USC § 254) or correction of the named inventor (35 USC § 256). In addition, while the instant petition involves a disclaimer, 35 USC § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Bayer, supra.

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination, such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325; MPEP 1490. As further noted in MPEP 1490, the mechanisms to correct a patent (i.e., certificate of correction (35 USC § 255), reissue (35 USC § 251 (notwithstanding the filing of this reissue application and the instant petition reissue) and reexamination (35 USC § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer.

Even assuming, *arguendo*, the USPTO had some discretion in this matter, the reissue-- and this petition-- come far too late to remedy the situation in the patent. Note that the patent issued with the recorded terminal disclaimer on June 19, 1997. As noted in Vectra Fitness Inc. v. TNWK Corp, 49 USPQ2d 1144 (Fed. Cir. 1998) there is a compelling public interest in maintaining the public record of this or any patented file in the as-issued state:

The public is entitled to rely upon the public record of a patent in determining the scope of the patent's claims. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. See id.; see also Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1424, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (discussing the public-notice function of claims in the context of a doctrine of equivalence analysis). For example, the "recapture rule" prevents a patentee from regaining through reissue subject matter surrendered during prosecution, thus ensuring the ability of the public to rely on a patent's public record. See In re Clement, 131 F.3d 1464,

Thus the public has had over 4 years to rely on the terminal disclaimer recorded against the patent before this reissue was filed to remedy the circumstances recounted in the petition. It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to

Leggett v. Avery, 101 U.S. 246 (1879). As a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. Jentoft, supra.

Still further, any attempt, by way of a reissue application, to withdraw a recorded terminal disclaimer, while problematic at best, must necessarily fail when that attempt is initiated more than two years after grant of the original patent, due to the two year bar on broadening reissues set forth in 35 U.S.C. 251. See Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985). That is, since removal of a terminal disclaimer would necessarily [vertically or temporally] broaden the scope of the patented claims, such activity must be considered to be statutorily time barred herein. Id. Evasion of the stringent statutory and regulatory provisions which are now controlling as to any possible USPTO direct, or as requested here, indirect, treatment of the as-issued patent would manifestly be an improper application of 37 CFR 1.182. See 35 U.S.C. § 2(b)(2)(A). Thus, the requested relief simply cannot be granted by way of petition under 37 CFR 1.182. 37 CFR 1.182 may not be invoked to the contrary of any statutory requirement, as the USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 USC §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

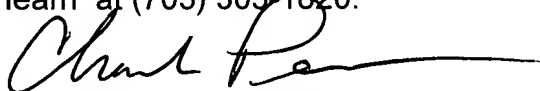
It should be noted that under 35 U.S.C. 253 and 37 CFR 1.321, the terminal disclaimer proffered in this reissue application could also be filed directly in the '345 patent.

DECISION

The petition is DENIED as to withdrawal of the terminal disclaimer recorded against the '345 patent.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The USPTO will not give further consideration or reconsideration to this matter.

Telephone inquiries related to this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson, Director
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy